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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/966,151 | 09/27/2001 | Kenji Nakajima | | 4076 |

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EXAMINER

QUAN, ELIZABETH S

ART UNIT PAPER NUMBER

1743

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,151

Applicant(s)

NAKAJIMA, KENJI

Examiner

Elizabeth Quan

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: (5). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1743

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,104,812 to Kurn et al.

Claim 1 has been treated as a device claim. Kurn et al. disclose a test stick where test paper (34) is partially bonded to a water-repelling mounting paper (42), such that a gap (50) is formed between a separated portion of the test paper and the mounting paper for a test solution to flow into (col. 5, lines 4-45; col. 8, line 40-col. 9, line 42). The mounting paper, which is insoluble liquid medium, may be made of a variety of organic and inorganic materials, both natural and synthetic, and combinations thereof, such as polyethylene and polypropylene, in accordance with the statement that the mounting paper may be made of paper or plastic in the instant application (col. 5, lines 46-61).

Kurn et al. recognize that the device may be involved in conducting a variety of assays and the test paper may have certain reagents bound at predetermined sites thereon (col. 1, lines 23-25; col. 4, lines 63-68; col. 12, line 57-col. 13, line 2; col. 13, lines 31-55). Kurn et al. fail to explicitly disclose that the test paper is a pH test paper. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Kurn et al. to use pH test paper in order to determine the pH of samples as desired or necessary.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,582,684 to Vogel et al.

Claim 1 has been treated as a device claim. Vogel et al. disclose a test stick where test paper (14) is partially bonded to a water-repelling mounting paper (10), such that a gap (20) is formed between a separated portion of the test paper and the mounting paper for a test solution to

Art Unit: 1743

flow into (fig. 1). The mounting paper, which is non-absorbent and insoluble in the fluid or sample to be evaluated, can be made of glass or water-insoluble polymers (col. 3, lines 31-66).

Vogel et al. disclose that the device may be used for photo determination of a chemical component in a fluid (col. 1, lines 5-17). Vogel et al. fail to explicitly disclose that the test paper is a pH test paper. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Vogel et al. to use pH test paper to determine/identify chemical components by pH since it is very well known in the art.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,839,297 to Freitag et al.

Claim 1 has been treated as a device claim. Freitag et al. disclose a test stick where test paper (13) is partially bonded to a water-repelling mounting paper (2), such that a gap is formed between a separated portion of the test paper and the mounting paper for a test solution to flow into (figs. 1-5).

Frietag et al. disclose that the device may be used for analytical determination of a component of a body fluid (col. 1, lines 6-12). Frietag et al. further disclose that the test paper reacts with the sample to produce a detection signal, especially color change (col. 6, lines 25-33). Freitag et al. fail to explicitly disclose that the test paper is a pH test paper. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Frietag et al. to use color changing pH test paper to determine/identify chemical components by pH since it is very well known in the art.

Art Unit: 1743

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They include one or more limitations in the claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (703) 305-1947. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elizabeth Quan
Examiner
Art Unit 1743

eq


Jill Warden
Supervisory Patent Examiner
Technology Center 1700